

## REMARKS

As a preliminary matter, please assign this application new attorney document number 4007.005, and send all future correspondence relating to this application to Liniak Berenato & White, 6550 Rock Spring Drive, Suite 240, Bethesda, MD 20817. Filed herewith are executed Power of Attorney documents and a Rule 3.73(b) Statement. Thank you.

Claims 1-6, 9-31, and 35-40 remain pending in this application. Claims 30, 31, and 35-37 have been withdrawn from consideration. Claims 38-40 have been added. The amendments to claims 1, 2, and 29 are supported throughout the original disclosure, including at page 10, lines 11-14 and page 10, line 22 to page 11, line 5. New claims 38 and 40 are supported throughout the specification, including at page 13, lines 6-13. Claim 39 is substantially identical to claim 1, but omits the phrase “substantially trapezoidal section.” Approval and entry of the new claims are respectfully requested.

### ***Election/Restriction***

Applicant respectfully submits that upon allowance of claim 1, non-elected claims 30-37 must be rejoined. Claim 1 is generic to claim 30, inasmuch as claim 30 depends from claim 1. Reasons in support of the allowance of claim 1 are set forth below.

### ***Drawings***

The drawings have been objected to under 37 C.F.R. § 1.83(a) for not showing the first and second elongate pins and washers. Applicant respectfully submits that this objection is misplaced and traverses the objection.

Applicant respectfully submits that the elongate pins and washers have been omitted from the figures so that the remaining, novel features of the invention are not obscured. From the description provided in the specification and associated with figure 2 and the knowledge and understanding of those skilled in the art, it is abundantly apparent where the elongate pins and washers are positioned. The Examiner's proposed drawing change would not contribute to a better understanding of the invention than provided by the original disclosure, and might cause confusion. For example, the pin heads, if shown, might obscure the non-tapered configuration of the counterbores. For these reasons, Applicant respectfully requests that the objection be withdrawn.

### ***Specification***

The abstract of the disclosure and specification been objected to for a number of informalities. In response, Applicant has amended the abstract and specification in accordance with the Examiner's constructive suggestions.

Applicant respectfully requests withdrawal of the objections.

### ***Claim Rejections -- 35 U.S.C. § 112***

Claims 1-6 and 9-26 have been rejected under 35 U.S.C. § 112, second paragraph, as being "unclear as to what is being referred to as 'the substantially flat horizontal surface.'"

Applicant respectfully traverses this rejection. The Office Action does not make clear the specific rationale for this rejection, or how it might be overcome. Applicant assumes that the Examiner has premised this rejection on a lack of antecedent basis. In response, Applicant respectfully submits that antecedent basis for the contested phrase is provided in the preamble of claim 1. If this antecedent basis does not satisfy the Examiner, Applicant is

agreeable to amending the body of claim 1 to change “the substantially flat horizontal surface” to --a substantially flat horizontal surface--.

Applicant notes the addition of new dependent claims 38 and 40, which further define the substantially flat horizontal surface.

With regard to the Examiner’s rejection of claim 11, Applicant points out that the term “teardrop profile” is found in claim 13, not claim 11. The Examiner’s attention is directed to page 13, lines 14-16 and the figures, which clearly reference and illustrate what is intended by the term “teardrop profile”. Applicant is aware of no better way to describe a shape than by illustration. Applicant notes that a search of the USPTO.GOV website revealed about 500 patents with the term “teardrop” used in the claims.

For these reasons, Applicant respectfully submits that all claims are in full compliance with Section 112, and respectfully requests reconsideration and withdrawal of this rejection.

### ***Claims Rejections -- 35 U.S.C. § 103***

Claims 1-6 and 9-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Winegardener Declaration in view of U.S. Patent No. 4,220,052 to Sheldon (hereinafter “Sheldon”).

Applicant respectfully traverses this rejection.

Applicant reminds the Examiner that none of the allegations made in the Winegardener Declaration are acknowledged by Applicant to be true. *See* IDS of May 20, 2003. The Declaration was created by a third party, and forwarded by Applicant to the Patent Office without modification. Applicant has reserved all right to challenge the accuracy, completeness, truthfulness, genuineness, reliability, admissibility or any other ground for consideration of the Declaration.

In this regard, the Examiner's attention is directed to the attached Declaration of Christopher Marshall, and in particular paragraphs 1 to 6 of the Marshall Declaration. Mr. Marshall has had extensive experience in dealing with silent chain products in the course of his employment. Mr. Marshall is also familiar with the companies Rexnord Corporation, Link Belt, and Ramsey Corporation referred to in the Winegardener Declaration, and has encountered their products in the normal course of his employment. Mr. Marshall would have expected to have encountered the alleged product described in the Winegardener Declaration in the normal course of his employment, had said product existed and been used or sold to the public, as alleged in the Winegardener Declaration. However, Mr. Marshall never has come across any technical sales brochure, advertising in trade journals, or public demonstrations of the alleged product, despite his familiarity with and exposure to products of this nature. To the best of Mr. Marshall's knowledge, the products described in the Winegardener Declaration were never sold, offered for sale, or marketed as a solution to wearing of pin heads within silent conveyor chains.

For the above reasons, Applicant respectfully submits that the Section 103(a) rejection is misplaced and should be withdrawn.

Additionally, Applicant respectfully submits that even if the product described in the Winegardener Declaration is prior art, which it apparently is not, a *prima facie* case of obviousness has not been established. In accordance with the invention, the heads of adjacent elongate pins are seated in flat non-tapered recesses (*i.e.*, counterbores) in an enclosure member and are therefore fully sunk into the counterbores. This feature serves to solve a longstanding problem in the art, namely the fact that the heads of the elongate pins (which inherently have to be built up, otherwise they simply break off) tend to stick out and are therefore vulnerable to catching and breaking, for example, on machine components. In

contrast, the enclosure member described in the Winegardener Declaration possesses pin heads that are not seated in a flat recess (*i.e.*, a counterbore), but in a tapered countersink, as is clear from the side view presented in the first two exhibits of the Winegardener Declaration. Thus, contrary to what Winegardener states in paragraph 4 of his declaration, this construction exposes the pin head and leaves it vulnerable to the precise problem, namely, catching and breakage, overcome by the present invention.

A tapered counterbore would not have been thought by a person of ordinary skill in the art to be a successful solution to preventing damage to the pin head in a silent conveyor chain. The tapered counterbore would in all probability leave the pin head protruding and susceptible to damage. The tapered counterbores did not function to protect the protruding heads. The Examiner has not pointed to any teaching in the art to suggest that the tapered counterbores might be used or modified for this purpose. *See* the Marshall Declaration, ¶ 10.

As emphasized by its title, the object of the Sheldon patent is to provide a self-securing pin caused by an interference fit differential between the ends of the pin and their respective receiving bores. In practice, this is achieved by providing a greater degree of knurling on a first end of the pin than on a second end of the pin. *See* column 2, lines 54-59 and column 3, lines 5-11. The fact that figures 1 to 3 illustrate the first and second ends of the pin accommodated within non-tapered counterbores is wholly inconsequential to achieving the object of the invention disclosed in Sheldon. The lack of significance that Sheldon gives to its counterbores allegedly providing a protective function is evident from the fact that in the second embodiment illustrated in figures 4 to 6 of Sheldon, the first end of the pin ("a") is not accommodated within the counterbore but projects from it. *See* column 2, lines 11-14.

For these reasons, it is respectfully submitted that the Sheldon patent does not provide the requisite motivation to modify the tapered counterbore of Winegardener to attain a non-tapered counterbore for protecting the pin head.

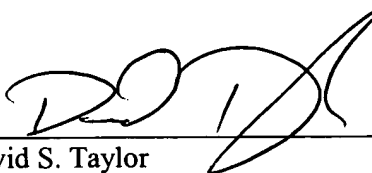
The Examiner's contention that there is motivation to make this change "in order to allow for the riveted head of the pin to have uniform thickness so as to strengthen the chain in the lateral direction" is the result of hindsight analysis and without support. The technical reality is that the change from a tapered to a non-tapered counterbore does not increase lateral strength in the chain and this fact would have been known to a person having ordinary skill in the art. *See* the Marshall Declaration, ¶¶ 7-10. Even if the Examiner was correct, the lateral strength of the chain is in fact of little or no importance to the skilled person when compared to the importance of the strength of the chain lengthwise. It is the latter longitudinal strength which is paramount in determining the overall effectiveness of the chain and its ability to withstand lengthwise distortion such as buckling.

For these reasons, Applicant respectfully submits that the Examiner's rejection of independent claims 1 and 29 is misplaced. Applicant further respectfully submit that claims 2-6 and 9-28, being dependent from claim 1 and including all of the distinguishing features thereof, is patentable over the applied art for the above-advanced reasons. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the Section 103(a) rejection.

Applicant respectfully submits that new claim 39 includes the above-discussed novel features of claim 1, and therefore is patentable over the applied art for the above-advanced reasons. Further, new claims 38 and 40, being dependent from claims 1 and 39, respectfully, and including all of the distinguishing features thereof, are also patentable for the reasons advanced above.

If, after reviewing the above amendments and remarks, the Examiner has any questions, the Examiner is respectfully requested to contact the undersigned, by telephone, to schedule an interview to address such issues.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. S. Taylor', written over a horizontal line.

David S. Taylor  
Reg. No. 39,045

February 7, 2005

LINIAK, BERENATO & WHITE  
6550 Rock Spring Drive  
Suite 240  
Bethesda, Maryland 20817  
Telephone: (301) 896-0600  
Facsimile: (301) 896-0607

Attachment: Declaration of Christopher Marshall